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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,617	01/08/2002	Ingo F. Herrmann	089317-000000US	4164

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EXAMINER
RAM, JOCELYN DEBRA
ART UNIT

3739  
DATE MAILED: 05/07/2003  
7

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	Application No.	Applicant(s)
	09/913,617	HERRMANN, INGO F.
	Examiner Jocelyn D Ram	Art Unit 3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 08 January 2002.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-12 and 14-24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-12 and 14-24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 08 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
 - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 - If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities:

“medicamentous” is not a word; in all instances, “defence” should be changed to - defense--, “anaesthisation” should be changed to - anesthetization--, “utilisation” should be changed to -utilization--, and “fibroscope” should be changed to -fiberscope--; page 11, line 17, “is” should be changed to -its--; page 15, line 17, “optimised” should be changed to --optimized--; page 22, line 4, “stabilising” should be changed to - stabilizing--; and page 22, line 6, “stabilisation” should be changed to -stabilization--.

Appropriate correction is required.

### *Claim Objections*

Claims 1-12 and 14-24 are objected to because of the following informalities: “fibroscope” should be changed to -fiberscope” in all instances; claim 1, line 14, “holding/ and or” should be changed to -holding and/or--; claim 7, line 5, “and/in or” should be changed to -and/or in--; claim 16, line 2, “formed by” should be deleted; and claim 19, line 5, “the light/image transmission” should be changed to -the light/transmission passages--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 7, 9, 10, 12, 14 and 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "the unit" in line 3, "the fibroscope part" in line 11, and "their longitudinal directions" in lines 12-13; claim 10 recites the limitation "the insertion section" in line 2; and claim 19 recites the limitation "the unit" in line 3. There is insufficient antecedent basis for these limitations in the claims.

In order to have proper antecedent basis and avoid indefiniteness, when a limitation is mentioned the first time, it should be preceded by "a" and when it is subsequently mentioned, it should be preceded by "the" or "said". Thus, it is suggested that the following modifications be made. Claim 1, line 3, "endoscope" should be changed to -the endoscope--; claim 1, lines 3-4, "additional instrument" should be changed to -the at least one additional instrument--; claim 1, line 5, "insertion section" should be changed to -an insertion section--; claim 1, line 9, "fibroscope part" should be changed to -a fibrescope part--; claim 4, line 2, "fixation forceps" should be changed to -a fixation forceps--; claim 4, lines 2-3, "a work passage" should be changed to -the work channel; claim 4, line 4, "a work channel" should be changed to -the work

channel--; claim 19, line 3, "endoscope" should be changed to -the endoscope--; claim 19, line 3, "additional instrument" should be changed to -the at least one additional instrument--; claim 19, line 4, "insertion section" should be changed to -an insertion section--. In claim 1, line 9, and claim 19, lines 6-7, it is unclear if "the closed unit" is referring to the same "unit" recited previously in the claim.

Although the use of "and/or" is not necessarily indefinite, in claims 7, 9 and 12 the use of multiple recitations of "and/or" renders the claim confusing. It is unclear which permutations of combinations are being claimed since to replace each "and/or" with either "and" or "or" does not make sense in all instances.

Claims 20-24 are dependent on claim 18, which creates numerous antecedent basis problems and indefiniteness. It is suggested that the dependency of claims 20-24 be changed to depend from independent claim 19. In the following art rejections, such a dependency has been assumed.

Claims 14 and 20 describe the invention in terms of use with a particular body orifice. Therefore, whether a device falls within the scope of the claims cannot be ascertained until a particular body orifice engages the device. Consequently, the claims are indefinite. *Ex parte Brummer* 12 USPQ2d 1653 (BdPatApp & Inter 1989). In the following art rejections, these claims have been read as broadly as claimed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 10, 14, 15, 17-21, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Bass et al. (3,858,577). Bass shows a deformable endoscope (15) that has one or more light (16, 17) and image (18) transmission passages and in which at least one additional instrument (fiber 30 for transmission of laser 33) is provided, wherein the endoscope has a non-round cross-section (Fig. 2) along a longitudinal section, and wherein the passages and instrument form a closed unit, further comprising a holding device having a loop/fastening hoop (straps 32) at the distal end to engage the instrument (30), wherein the cross-section corresponds to an isosceles triangle with rounded corners and the instrument is laterally spaced with respect to the center of the cross-section.

Claims 1, 2, 11, 12 and 14-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverstein (5,025,778). Silverstein shows a deformable endoscope (30) that has one or more light and image transmission passages (46) and in which at least one additional instrument (biopsy forceps 146) is provided, wherein the endoscope has

a non-round cross-section (Fig. 2B, 3B) along a longitudinal section, and wherein the passages and instrument form a closed unit, further comprising a holding device/jacket hose (elastic tubing 54) for the instrument (146), wherein the cross-section corresponds to an isosceles triangle with rounded corners and the instrument is laterally spaced with respect to the center of the cross-section.

Claims 1, 2, 5-9, 14, 16-20 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Adair (5,643,175). Adair shows a deformable endoscope (E) that has one or more light (20) and image (14) transmission passages and in which at least one additional instrument (forceps 122) is provided, wherein the endoscope has a non-round cross-section (col 2, line 43) along a longitudinal section, and wherein the passages and instrument form a closed unit, further comprising a holding device (key 36 and keyway 38, or integral magnets 226 and 230) for releasably holding the instrument (122), and the instrument is laterally spaced with respect to the center of the cross-section.

Claims 19-21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Harhen (5,685,822). Harhen shows a deformable endoscope (10) that has one or more light/image transmission passages (32, 34) and in which at least one additional instrument (endoscopic tool within channel 14) is provided, wherein the endoscope has

a non-round cross-section (Fig. 2) along a longitudinal section, and wherein the passages and instrument form a closed unit.

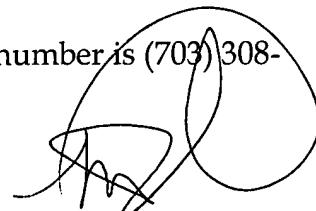
### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakao et al. (5,217,001), Jones (5,503,616), Bacich et al. (5,749,889) and Reydel et al. (5,259,366) show endoscope sheaths with instrument channels for attaching to an endoscope. Bonnet (5,509,892) and Thompson (5,891,013) show endoscopes with non-circular cross sections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn D Ram whose telephone number is (703) 308-6392. The examiner can normally be reached on Mon-Fri, 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



JR  
May 1, 2003

LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700